

### **REMARKS**

This communication is a full and timely response to the aforementioned Office Action dated November 27, 2007. By this communication, claims 1-3, 6-8, 12-17, 19-24 and 26-33 are amended, and claims 11, 18, 35 and 36 are cancelled. Claims 4, 5, 9 and 10 are not amended and remain in the application. Thus, claims 1-10, 12-17, 19-24 and 26-35 are pending in the application. Claims 1-3, 6-8, 12-17, 19-24, 26-28 and 31-33 are independent.

Reconsideration of the application and withdrawal of the rejections of the claims are respectfully requested in view of the foregoing amendments and the following remarks.

#### **I. Amendments to the Drawings**

A replacement formal drawing of Figure 7 is submitted herewith to correct an informality. Figure 7 is a flowchart showing the steps of an e-mail delivery process of mail server 21a to deliver an e-mail containing an attachment to MFP 11a, as illustrated in Figure 1. As described in paragraph [0079] spanning pages 34 and 35 of the specification, the process includes step S303 in which the mail server 21a judges whether the volume of a received e-mail, including an attachment thereto, is less than a capacity limit of the mail server 21a. If the volume of the e-mail is less than an upper limit of the capacity of the mail server 21a, the e-mail is delivered (Yes in step S303, and step S306). On the other hand, if the volume of the received e-mail exceeds the upper limit of the capacity of the mail server 21a, steps S04 and S05 are performed prior to step S306, as described in paragraph [0080] spanning pages 35 and 36 of the specification.

However, the illustration of step S303 in original Figure 7 is misdescriptive because steps S304 and S305 are identified as being skipped if the volume of the received e-mail exceeds the upper limit of the capacity of the mail server 21a. Accordingly, the illustration of step S303 in Figure 7 has been revised to replace the term "exceeds" with the term "less than", to properly designate the distinction between the steps performed when the volume of the received e-mail is less than the upper limit of the capacity of the mail server 21a, and the steps performed when it is not.

## **II. Amendments to the Specification**

Minor editorial revisions have been made to the specification to correct informalities. Approval and entry of the amendments to the specification are respectfully requested.

## **III. Substitute Abstract**

The original abstract has been replaced with a substitute abstract that overcomes the informalities identified on page 2 of the Office Action. Accordingly, Applicant respectfully requests that the objection to the abstract be withdrawn. A clean version of the substitute abstract is attached hereto.

## **IV. Claim Objection**

Claim 2 has been amended to incorporate the revisions kindly suggested by the Examiner. Accordingly, Applicant respectfully requests that the objection to claim 2 be withdrawn.

## **V. Rejections Under 35 U.S.C. § 101**

Claims 26-36 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is believed to be moot with respect to claim 36 in view of its cancellation.

The preambles of independent claims 26-28 and 31-33 have each been amended to recite "A computer-readable medium having an image processing program stored thereon for causing an image processing device to execute." Accordingly, by reciting a computer-readable medium as having a program stored thereon for causing the image processing device to execute the steps recited in claims 26-28 and 31-33, the structural and functional interrelationships between the program, computer-readable medium and image processing device permit the program's functionality to be realized. Therefore, claims 26-28 and 31-33, as well as

claims 27-30, 34 and 35 which depend therefrom, recite patentable subject matter under 35 U.S.C. § 101.

Accordingly, Applicant respectfully requests that the rejection of claims 26-35 be withdrawn.

## **VI. Amendments to Claims**

The amendments to the claims presented herein, in addition to the amendments discussed in sections IV and V above, are voluntary amendments to correct grammatical and idiomatic informalities and to obviate potential unintended interpretations of the recited features. The amendments to the claims are not presented for the purposes of patentability and do not narrow the scope of protection of the claimed inventions.

## **VII. Rejections Under 35 U.S.C. § 102**

A. Claims 1-36 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Takayama (U.S. Patent Publication No. 2002/0140986). This rejection is believed to be moot with respect to 11, 18, 25 and 36 in view of the cancellation of these claims.

This rejection is respectfully traversed for the following reasons.

### **(1) Independent Claims 1, 12, 19 and 26**

Claim 1 recites an image processing device comprising an e-mail receiving means for receiving a first e-mail transmitted with an attachment file but deprived of the attachment file due to a capacity limit of a mail server. The image processing device of claim also comprises an e-mail transmitting means for transmitting a second e-mail, which contains information of an online location and a transfer request for transferring the attachment file, to a transmission source of the first e-mail and other transmission destinations of the first e-mail in response to receiving of the first e-mail.

The image processing device of claim 1 also comprises an attachment file receiving means for receiving the attachment file transmitted in response to the second e-mail from equipment pertaining to the transmission source of the first e-

mail or another transmission destination of the first e-mail. Furthermore, the image processing device of claim 1 comprises an image forming means for forming images of the attachment file in response to receiving the attachment file.

Accordingly, claim 1 recites that the image processing device transmits the second e-mail in response to receiving the first e-mail from which the attachment file transmitted therewith is deprived. In addition, claim 1 recites that the image processing device receives the attachment file, which was deprived from the first e-mail, from equipment pertaining to the transmission source of the first e-mail or another transmission destination source of the first e-mail, in response to transmitting the second e-mail to the transmission source of the first e-mail or another transmission destination source of the first e-mail.

Claim 12 recites an image processing device comprising constituent parts corresponding to the means elements of claim 1. Claims 19 and 26 recite a method and program comprising steps corresponding to the operative functions of the means and parts recited in claims 1 and 12.

The following discussion of the rejections of claims 1, 12, 19 and 26 focuses on the features of claim 1 for the sake of brevity. However, the Office is respectfully requested to observe that the discussion of the features of claim 1 in view of the applied references also applies to the features of claims 12, 19 and 26.

Takayama discloses a multi-function peripheral (MFP) 1 that includes an e-mail transmission unit 31, which transmits and receives e-mail to/from a mail server MS that is external to the MFP 1 (see Figure 3). The e-mail transmission unit 31 transmits three types of e-mail: (1) e-mail to which no files are attached, (2) e-mail ML1 to which data such as image data D are attached, and (3) e-mail ML2 to which a prescribed tool program TP is attached (see paragraphs [0049] and [0055]). The MFP 1 also includes a recognition unit 33 which recognizes e-mail transmission errors. A controller 34 of the MFP 1 controls the e-mail transmission unit 31 such that a first e-mail ML1 containing a data attachment D is sent to a prescribed recipient computer 90. If the recognition unit 33 recognizes an error regarding the first e-mail ML1, the controller 34 controls the e-mail transmission unit such that a second e-mail ML2 having a tool program TP attached thereto will be sent to the recipient computer 90 (see paragraphs [0051] and [0052]).

In operation, Takayama discloses that the e-mail transmission unit 31 transmits e-mail ML1 containing attachment D to a recipient computer 90 via the external mail server MS. If the recipient does not receive e-mail ML1, MFP 1, which is the sending apparatus, is notified by the server that detected the transmission error, which transmits an e-mail ME (error notification message) to MFP 1 that indicates the occurrence of the transmission error (see paragraph [0058]). Upon receiving the error notification message ME, the MFP 1 obtains the information (IP address, e-mail address) pertaining to the recipient for the sent e-mail ML1 together with the information of the attachment D (file name of image data D) by analyzing the information contained in the header of the error notification message ME (see paragraph [0061]).

Takayama discloses that when such an error notification message ME is received, MFP 1 creates a new e-mail ML2 having a tool program TP attached thereto. The image data D that was attached to the sent e-mail ML1 is not attached to the e-mail ML2, because the tool program TP is attached thereto instead. The image data D that was attached to the sent e-mail ML 1 is stored in a hard drive 231 of the MFP 1 so that it can be accessed by the recipient computer 90 that was intended to receive the image data D. The tool program TP contains access information that enables the intended recipient of the e-mail ML1 to obtain the image data D from the hard drive 231 of the MFP 1. The tool program TP containing such access information is transmitted with the e-mail ML2 to the original recipient of the e-mail ML1 to enable the recipient to obtain the image data D from the hard drive 231 of the MFP 1 (see paragraphs [0068]-[0073]).

The Office asserted that the e-mail ML2 containing the tool program TP corresponds to the second e-mail recited in claim 1. This assertion is not supportable for the following reasons.

First, the Office's overall premise in rejecting claim 1 is not supportable. In rejecting claim 1, the Office asserted that the mail server MS corresponds to the e-mail receiving means and the e-mail transmitting means. Claim 1 recites that the e-mail transmitting means transmits the second e-mail, which contains information of an online location and a transfer request for transferring the attachment file, to a

transmission source of the first e-mail and other transmission destinations of the first e-mail in response to receiving of the first e-mail.

Takayama discloses that the mail server MS receives the e-mail ML2 from MFP 1 and transmits it to recipient computer 90, as is shown by arrow AR3 in Figures 4 and 8 (see paragraph [0068]). However, in contrast to claim 1, the mail server MS does not transmit the e-mail ML2 to the recipient computer in response to receiving the e-mail ML1 having the image data D attached thereto. Furthermore, Takayama does not disclose or suggest that the mail server MS transmits the e-mail ML2 to the recipient computer 90 and other transmission destinations of the e-mail ML1.

In addition, Takayama does not disclose or suggest that the e-mail ML2 contains a request for transferring the attachment file D. Takayama discloses that when the tool program TP attached to the e-mail ML2 is opened on the recipient computer 90, the recipient computer 90 is then able to obtain the image data D that is stored in the MFP 1 or the external server SV (see paragraphs [0071]-[0073] and [0079]-[0082], and Figures 4 and 8). Takayama does not disclose or suggest that the tool program TP attached to e-mail ML2 contains any request for transferring the attachment file D to the recipient computer 90. On the other hand, the tool program TP contains IP information on where the attachment file D is stored so that the recipient computer 90 can retrieve the attachment file D from the MFP 1 or the external server SV (see paragraphs [0072] and [0082]).

Furthermore, as described above, Takayama does not disclose or suggest that the mail server MS transmits e-mail ML2 in response to receiving e-mail ML1.

Accordingly, the mail server MS of Takayama cannot correspond to the e-mail transmitting means as recited in claim 1.

Applicant respectfully submits that neither the MFP 1 nor recipient computer 90 of Takayama correspond to the e-mail transmitting means of claim 1. The MFP 1 transmits e-mail ML2 in response to receiving the error notification message ME from the mail server that was incapable of delivering e-mail ML1 to the recipient computer 90 (see paragraphs [0061]-[0065]). However, the error notification message ME is not an e-mail transmitted with an attachment file but deprived of the attachment file due to a capacity limit of a relaying mail server. Takayama does not

disclose or suggest that the recipient computer 90 transmits a second e-mail in response to receiving either e-mail ML1 or e-mail ML2. On the other hand, when the recipient computer 90 receives e-mail ML2, the recipient computer 90 accesses the hard drive of the MFP or the external server SV to obtain the stored image data D by using a data transfer protocol such as FTP and HTTP (see paragraph [0072]).

Therefore, Applicant respectfully submits that Takayama does not disclose an image processing device comprising an e-mail transmitting means for transmitting a second e-mail, which contains information of an online location and a transfer request for transferring the attachment file, to a transmission source of the first e-mail and other transmission destinations of the first e-mail in response to receiving of the first e-mail, as recited in claim 1.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claim 1. Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claims 12, 19 and 26 for the same reasons.

(2) Independent Claims 6, 15, 22 and 31

Claim 6 recites an image processing device comprising a first e-mail receiving means for receiving a first e-mail transmitted with an attachment file but deprived of the attachment file due to a capacity limit of a relaying mail server. The image processing device of claim 6 also comprises an e-mail transmitting means for transmitting a second e-mail containing a response request for responding with online location information of equipment pertaining to a transmission source of the first e-mail or other transmission destinations of the first e-mail to the transmission source and the other transmission destinations in response to receiving of the first e-mail.

Accordingly, claim 6 recites that the image processing device, which has received the first e-mail deprived of the attachment file, transmits the second e-mail, in response to receiving the first e-mail, to the transmission source of the first e-mail and other transmission destinations of the first e-mail. Claim 6 recites that the second e-mail contains a response request for responding with online location information of equipment pertaining to the transmission source of the first e-mail or

other transmission destinations of the first e-mail.

Claim 15 recites an image processing device comprising constituent parts corresponding to the means elements of claim 6. Claims 22 and 31 recite a method and program comprising steps corresponding to the operative functions of the means and parts recited in claims 6 and 15.

The following discussion of the rejections of claims 6, 15, 22 and 31 focuses on the features of claim 6 for the sake of brevity. However, the Office is respectfully requested to observe that the discussion of the features of claim 6 in view of the applied references also applies to the features of claims 15, 22 and 31.

In rejecting claim 6, the Office asserted that the e-mail transmitting means of claim 6 corresponds to the mail server MS of Takayama, and that the second e-mail of claim 6 corresponds to the error notification message ME of Takayama. This assertion is not supportable for the following reasons.

First, the error notification message ME transmitted from the mail server MS of Takayama does not contain any request for responding with online location information of equipment pertaining to the transmission source of the e-mail ML1 or other transmission destinations of the e-mail ML1. Takayama discloses that the error notification message ME contains information (IP address, e-mail address) pertaining to the recipient for the sent e-mail ML1 together with the information of the attachment D (file name of image data D) transmitted with the sent e-mail ML1 (see paragraph [0061]).

It is unclear how the Office interpreted the error notification message ME as including a request for information, because the error notification message ME merely includes the information included with the first e-mail ML1 so that the MFP 1 can determine which recipient computer 90 did not receive the e-mail ML1.

Therefore, Applicant respectfully submits that Takayama does not disclose or suggest the e-mail transmitting means as recited in claim 6, in addition to the corresponding features of claims 15, 22 and 31.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claim 6. Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claims 15, 22 and 31 for the same reasons.



(3) Independent Claims 2, 13, 20 and 27

Claim 2 recites an image processing device comprising a first e-mail receiving means for receiving a first e-mail having an attachment file, and an image forming means for forming images of the attachment file.

In addition, the image processing device of claim 2 comprises a second e-mail receiving means for receiving a second e-mail, which contains online location information of equipment pertaining to another transmission destination of the first e-mail and a transfer request for transferring the attachment file to the another transmission destination, from the another transmission destination.

Furthermore, the image processing device of claim 2 comprises an attachment file transferring means for transferring the attachment file to equipment pertaining to the another transmission destination in response to receiving of the second e-mail, when it is possible to access the equipment pertaining to the another transmission destination based on the online location information of the equipment pertaining to the another transmission destination.

Accordingly, claim 2 recites that an image processing device for forming images of the attachment file received with the first e-mail comprises functional elements for receiving a second e-mail, and transferring the attachment file in response to receiving the second e-mail. Claim 2 recites that the second e-mail contains online location information of equipment pertaining to another transmission destination of the first e-mail and a transfer request for transferring the attachment file to the another transmission destination.

Claim 13 recites an image processing device comprising constituent parts corresponding to the means elements of claim 2. Claims 20 and 27 recite a method and program for an image processing device to execute steps corresponding to the operative functions of the means and parts recited in claims 2 and 13.

The following discussion of the rejections of claims 2, 13, 20 and 27 focuses on the features of claim 2 for the sake of brevity. However, the Office is respectfully requested to observe that the discussion of the features of claim 2 in view of the applied references also applies to the features of claims 13, 20 and 27.

In rejecting claim 2, the Office asserted that the first e-mail receiving means corresponds to the mail server MS of Takayama, the image forming means corresponds to the MFP 1 of Takayama, the second e-mail receiving means corresponds to the recipient computer 90, and the attachment file transferring means corresponds to the tool program TP attached to the e-mail ML2. The Office asserted that second e-mail recited in claim 2 corresponds to the e-mail ML2. These assertions are not supportable for the following reasons.

The recipient computer 90 of Takayama cannot correspond to the second e-mail receiving means of claim 2, because the recipient computer 90 receives the e-mail ML2. The e-mail ML2 of Takayama cannot correspond to the second e-mail of claim 2, because the e-mail ML2, including the tool program TP, does not contain online location information of equipment pertaining to another transmission destination of the e-mail ML1. On the other hand, the tool program TP includes access information for accessing a storage device of the MFP 1, which transmitted the e-mail ML1, or the external server SV, in which the MFP 1 has stored the attachment file D (see paragraphs [0065] and [0086]).

The external server SV is not another transmission destination of the e-mail ML1. As described in paragraph [0081], Takayama discloses "[a]s shown in FIG. 8, the image data D attached to an e-mail ML1 is also forwarded by the MFP 1 to a prescribed external server SV separately from the e-mail ML1, as indicated by an arrow AR2, and is stored therein" (emphasis added). Accordingly, Takayama does not disclose that the external server SV receives the e-mail ML1. Consequently, the e-mail ML2 of Takayama cannot correspond to the second e-mail of claim 2, because the e-mail ML2, including the tool program TP, does not contain online location information of equipment pertaining to another transmission destination of the e-mail ML1.

Therefore, the recipient computer 90 receiving the e-mail ML2 cannot correspond to the second e-mail receiving means as recited in claim 2. Similarly, the mail server MS receiving the e-mail ML2 cannot correspond to the second e-mail receiving means as recited in claim 2.

Furthermore, the MFP 1 of Takayama cannot correspond to the second e-mail receiving means of claim 2, because the error notification message ME received by

the MFP 1 does not contain online location information of equipment pertaining to another transmission destination of the e-mail ML1 and a transfer request for transferring the attachment file D to the another transmission destination. On the other hand, the error notification message merely identifies the IP address of the recipient computer 90 as well as information of the attachment file D.

Accordingly, Applicant respectfully submits that Takayama does not disclose or suggest a device for forming images of an attachment file comprises a function of receiving a second e-mail and a function of transferring the attachment file in response to receiving the second e-mail, as recited in claim 2.

Therefore, Applicant respectfully submits that Takayama does not disclose or suggest an image processing device that comprises all the recited elements of claim 2.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claim 2. Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claims 13, 20 and 27 for the same reasons.

(4) Independent Claims 7, 16, 23 and 32

Claim 7 recites an image processing device comprising a first e-mail receiving means for receiving a first e-mail having an attachment file, and an image forming means for forming images of the attachment file.

The image processing device of claim 7 also comprises a second e-mail receiving means for receiving a second e-mail containing a response request for responding with online location information, from another transmission destination of the first e-mail. In addition, the image processing device of claim 7 comprises an e-mail transmission means for transmitting a third e-mail containing the online location information to the another transmission destination in response to receiving of the second e-mail.

Furthermore, the image processing device of claim 7 comprises a transfer request receiving means for receiving a transfer request for transferring the attachment file transmitted in response to the third e-mail by equipment pertaining to the another transmission destination, and an attachment file transfer means for

transmitting the attachment file to equipment pertaining to the another transmission destination in response to the transfer request.

Accordingly, claim 7 recites that the image processing device which receives the first e-mail having an attachment file forms images of the attachment file. In addition, the image processing device of claim 7 comprises functional elements for receiving a second e-mail from another transmission destination of the first e-mail, and transferring the attachment file to the other transmission destination. Claim 7 recites that the second e-mail received from the another transmission destination of the first e-mail contains a response request for responding with online location information.

Claim 16 recites an image processing device comprising constituent parts corresponding to the means elements of claim 7. Claims 23 and 32 recite a method and program for an image processing device to execute steps corresponding to the operative functions of the means and parts recited in claims 7 and 16.

The following discussion of the rejections of claims 7, 16, 23 and 32 focuses on the features of claim 7 for the sake of brevity. However, the Office is respectfully requested to observe that the discussion of the features of claim 7 in view of the applied references also applies to the features of claims 16, 23 and 32.

In rejecting claim 7, the Office asserted that the first e-mail receiving means corresponds to the mail server MS of Takayama, the image forming means corresponds to the MFP 1 of Takayama, and the second receiving e-mail means corresponds to the function of the MFP 1 in receiving the error notification message ME. This assertion is not supportable for the following reasons.

The MFP 1 cannot correspond to the image forming means of claim 7, because the MFP 1 does not receive the e-mail ML1 having the attachment D. Rather, the MFP 1 sends the e-mail ML1 having the attachment file. Claim 7 recites that the image forming means forms "images of said attachment file." Accordingly, the phrase "said attachment file" refers to the attachment file received with the first e-mail. However, the MFP 1 does not receive the e-mail ML1.

Furthermore, Applicant respectfully submits that the MFP 1 cannot correspond to the second e-mail receiving means as recited in claim 7. Claim 7 recites that the second e-mail receiving means receives a second e-mail containing

a response request for responding with online location information, from another transmission destination of the e-mail ML1. Takayama discloses that the error notification message ME contains information (IP address, e-mail address) pertaining to the recipient for the sent e-mail ML1 together with the information of the attachment D (file name of image data D) transmitted with the sent e-mail ML1 (see paragraph [0061]). Accordingly, the error notification message ME received by the MFP 1 does not contain any request for online location information of the MFP 1.

It is unclear how the Office interpreted the error notification message ME as including a request for information, because the error notification message ME merely includes the information included with the first e-mail ML1 so that the MFP 1 can determine which recipient computer 90 did not receive the e-mail ML1. Consequently, Applicant respectfully submits that Takayama does not disclose or suggest the second e-mail receiving means, as recited in claim 7.

Furthermore, Applicant respectfully submits that the MFP 1, mail server MS and recipient computer 90 cannot correspond to the attachment file transfer means as recited in claim 7. Claim 7 recites that the attachment file transfer means transmit the attachment file to equipment pertaining to the another transmission destination in response to the transfer request. The tool program TP contained in the e-mail ML2 enables the recipient computer 90 to obtain the attachment D from the hard drive of the MFP 1 or the external server SV. However, Takayama does not disclose or suggest that the MFP 1, mail server MS or recipient computer 90 transfer the attachment D to equipment pertaining to the another transmission destination of the e-mail ML1.

Accordingly, Takayama does not disclose or suggest a device for forming images of an attachment file comprises a function of receiving a second e-mail and a function of transferring the attachment file, as recited in claim 7.

Therefore, Applicant respectfully submits that Takayama does not disclose or suggest an image processing device that comprises all the recited elements of claim 7.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claim 7.

Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claims 16, 23 and 32 for the same reasons.

(5) Independent Claims 3, 14, 21 and 28

Claim 3 recites an image processing device comprising an e-mail transmitting means for transmitting a first e-mail having an attachment file.

The image processing device of claim 3 also comprises an e-mail receiving means for receiving a second e-mail from the transmission destination of the first e-mail. Claim 3 recites that the second e-mail contains online location information of equipment pertaining to the transmission destination of the first e-mail and a transfer request for transferring the attachment file.

Accordingly, claim 3 recites an image processing device comprising functional elements for receiving a second e-mail from the transmission destination of the first e-mail, where the second e-mail contains online location information of equipment pertaining to the transmission destination of the first e-mail and a transfer request for transferring the attachment file.

Claim 14 recites an image processing device comprising constituent parts corresponding to the means elements of claim 3. Claims 21 and 28 recite a method and program for an image processing device to execute steps corresponding to the operative functions of the means and parts recited in claims 3 and 14.

The following discussion of the rejections of claims 3, 14, 21 and 28 focuses on the features of claim 3 for the sake of brevity. However, the Office is respectfully requested to observe that the discussion of the features of claim 3 in view of the applied references also applies to the features of claims 14, 21 and 28.

In rejecting claim 3, the Office asserted that the e-mail transmitting means corresponds to the MFP 1 of Takayama, the second e-mail receiving means corresponds to the recipient computer 90 receiving the second e-mail ML2, and the attachment file transferring means corresponds to the function of the tool program TP in transferring the attachment file D to the recipient computer 90. This assertion is not supportable for the following reasons.

First, the recipient computer 90 cannot correspond to the second e-mail receiving means, because the recipient computer 90 receives the e-mail ML2 which

has the tool program TP attached thereto. As described above, the tool program TP does not contain online location information of equipment pertaining to a transmission destination of the e-mail ML1. Takayama discloses that the tool program TP includes access information for accessing the MFP 1, which transmitted the e-mail ML1, or the external server SV, in which the MFP 1 has stored the attachment file D (see paragraphs [0065] and [0086]).

The external server SV is not another transmission destination of the e-mail ML1. As described in paragraph [0081], Takayama discloses "[a]s shown in FIG. 8, the image data D attached to an e-mail ML1 is also forwarded by the MFP 1 to a prescribed external server SV separately from the e-mail ML1, as indicated by an arrow AR2, and is stored therein" (emphasis added). Accordingly, Takayama does not disclose that the external server SV receives the e-mail ML1. Consequently, the e-mail ML2 of Takayama cannot correspond to the second e-mail of claim 2, because the e-mail ML2, including the tool program TP, does not contain online location information of equipment pertaining to a transmission destination of the e-mail ML1.

Accordingly, Applicant respectfully submits that Takayama does not disclose or suggest a device for transmitting a first e-mail, and receiving a second e-mail, which contains online location information of the transmission destination of the first e-mail, from the transmission destination of the first e-mail, as recited in claim 3.

Therefore, Applicant respectfully submits that Takayama does not disclose or suggest an image processing device that comprises all the recited elements of claim 3.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claim 3. Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claims 14, 21 and 28 for the same reasons.

(6) Independent Claims 8, 17, 24 and 33

Claim 8 recites an image processing device comprising a first e-mail transmitting means for transmitting a first e-mail having an attached file.

The image processing device of claim 8 also comprises an e-mail receiving

means for receiving a second e-mail containing a response request for responding with online location information, from a transmission destination of the first e-mail.

In addition, the image processing device of claim 8 comprises a second e-mail transmission means for transmitting a third e-mail containing the online location information to the transmission destination in response to receiving of the second e-mail.

Claim 17 recites an image processing device comprising constituent parts corresponding to the means elements of claim 8. Claims 24 and 33 recite a method and program for an image processing device to execute steps corresponding to the operative functions of the means and parts recited in claims 8 and 17.

The following discussion of the rejections of claims 8, 17, 24 and 33 focuses on the features of claim 8 for the sake of brevity. However, the Office is respectfully requested to observe that the discussion of the features of claim 8 in view of the applied references also applies to the features of claims 17, 24 and 33.

The Office addressed the features of claim 8 by asserting that it recites similar features to claims 1-7. Based on this reasoning, the Office rejected claim 8 for the same reasons presented in rejecting claims 1-7. As demonstrated above, the Office's interpretation and application of Takayama to claims 1-7 are not supportable. Nevertheless, in view of the Office's reliance on Takayama in rejecting claim 8, the rejection of claim 8 on the basis of Takayama is traversed for the following reasons.

Neither the mail server MS nor the MFP 1 of Takayama can correspond to the e-mail receiving means or second e-mail transmission means of claim 8. In particular, neither the mail server MS nor MFP 1 receives a second e-mail from a transmission destination of the first e-mail, where the second e-mail contains a response request for responding with online location information. The mail server MS of Takayama receives and routes the e-mail ML1 and the e-mail ML2. However, neither of the e-mails ML1 and ML2 are transmitted from a transmission destination of the first e-mail ML1. Furthermore, neither of the emails ML1 and ML2 contain a request for responding with online location information.

The MFP 1 receives the error destination message ME. However, as described above, the error notification message ME transmitted from the mail server MS of Takayama does not contain a request for responding with online location



information. On the other hand, Takayama discloses that the error notification message ME contains information (IP address, e-mail address) pertaining to the recipient for the sent e-mail ML1 together with the information of the attachment D (file name of image data D) transmitted with the sent e-mail ML1 (see paragraph [0061]).

Accordingly, Applicant respectfully submits that Takayama does not disclose or suggest the first e-mail transmitting means and e-mail receiving means, as recited in claim 8.

Therefore, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claim 8. Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of claims 17, 24 and 33 for the same reasons.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Takayama does not disclose or suggest all the recited features of independent claims 1-3, 6-8, 12-17, 19-24, 26-28 and 31-33.

Therefore, Applicant respectfully submits that claims 1-3, 6-8, 12-17, 19-24, 26-28 and 31-33, as well as claims 4, 5, 9, 10, 29, 30, 34 and 35 which depend therefrom, are patentable over Takayama.

B. Claims 1-4, 6-9, 11-29, 31-34 and 36 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kirani et al. (U.S. Patent Publication No. 2002/0016818, hereinafter "Kirani"). This rejection is believed to be moot with respect to 11, 18, 25 and 36 in view of the cancellation of these claims.

This rejection is respectfully traversed for the following reasons.

Kirani discloses an e-mail delivery system that filters an attachment from an e-mail intended to be received on a recipient device based on the capabilities of the type of the recipient device. In the event that the attachment is too large for the capabilities of the recipient device, the attachment is removed from the email and stored in a repository of a mail delivery server, and the attachment is replaced with a link (URL) that references the network storage address at which the user of the recipient device can access the attachment. Kirani discloses that if the user retrieves the attachment by using the recipient device for which the attachment was

removed, the mail delivery server on which the attachment is stored modifies the size of the attachment to a size that the recipient device is capable of handling (see paragraphs [0063]-[0067], and Figure 3).

Applicant respectfully submits that the claimed invention is patentable over Kirani for the following reasons.

(1) Independent Claims 1, 12, 14 and 26

Claim 1 recites an image processing device comprising an e-mail receiving means for receiving a first e-mail transmitted with an attachment file but deprived of the attachment file due to a capacity limit of a relaying mail server.

In rejecting claim 1, the Office asserted the e-mail receiving means of claim 1 corresponds to an element in Figure 3 of Kirani, but the Office did not specify which element. The e-mail receiving means of claim 1 can, at best, correspond to the recipient device 350. This is the only correspondence possible, because the mail server 315 of Kirani receives the first e-mail complete with the original attachment. The recipient device 350 is the only element in Figure 3 which can be interpreted as corresponding to an e-mail receiving means for receiving a first e-mail transmitted with an attachment but deprived of the attachment file.

However, even if the recipient device 350 is interpreted as corresponding to the e-mail receiving means of claim 1, Kirani does not disclose or suggest the e-mail transmitting means of claim 1. The recipient device 350 does not transmit a second e-mail to the transmission source of the first e-mail and other transmission destinations of the first e-mail. On the contrary, the recipient device 350 accesses the attachment stored in the media storage repository 325 via the HTTP protocol by clicking on the link included in the attachment-removed e-mail transmitted from the mail server 315 so as to connect to the HTTP media delivery server 335. Accessing a link via the HTTP protocol does not constitute sending an e-mail. Furthermore, the extractor 320, repository 325, HTTP media delivery sever 335 and authentication database 330 of Kirani do not receive the first e-mail transmitted from the message originator 300.

Therefore, in contrast to claim 1, Kirani does not disclose or suggest an image processing device comprising e-mail transmitting means for transmitting a second e-

mail in response to receiving a first e-mail, whose attachment file has been deprived, to the transmission source of the first e-mail and other transmission destinations of the first e-mail.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claim 1. Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claims 12, 19 and 26 for the same reasons.

(2) Independent Claims 6, 15, 22 and 31

Claim 6 is patentable for the same reasons as claim 1. Namely, no other element in Figure 3 of Kirani can correspond to the first e-mail receiving means of claim 6, because only the recipient device 350 is disclosed as receiving the first e-mail having been deprived of the attachment thereto. As demonstrated above, the recipient device 350 of Kirani is not disclosed or suggested as transmitting a second e-mail to the transmission source of the first e-mail or other transmission destinations of the first e-mail.

Therefore, Kirani does not disclose or suggest all the recited features of claim 6. Thus, Applicant respectfully submits that claim 6 is patentable over Kirani. Applicant respectfully submits that claims 15, 22 and 31 are also patentable for the same reasons.

(3) Independent Claims 2, 13, 20 and 27

Claim 2 recites that an image processing device for forming images of the attachment file received with the first e-mail comprises functional elements for receiving a second e-mail, and transferring the attachment file in response to receiving the second e-mail. Claim 2 recites that the second e-mail contains online location information of equipment pertaining to another transmission destination of the first e-mail and a transfer request for transferring the attachment file to the another transmission destination.

Contrary to the Office's assertion, Kirani does not disclose or suggest that a device for forming images of an attachment comprise a function of receiving the second e-mail from another transmission destination of the first e-mail, and a

function of transferring the attachment file to the other transmission destination of the first e-mail in response to receiving the second e-mail, which contains the online location information of the other transmission destination of the first e-mail.

In rejecting claim 2, the Office asserted that the image forming means corresponds to the printer 107 as illustrated in Figure 1. The Office also asserted that the online location information contained in the second e-mail of claim 2 corresponds to the URL link that is transmitted in the attachment-removed e-mail to the recipient device 350.

However, as demonstrated above, Kirani does not disclose or suggest that the recipient device 350 transmits an e-mail to another transmission destination of the first e-mail, let alone transmitting an e-mail with online location information.

In rejecting claim 2, the Office also asserted that the second e-mail receiving means corresponds to the recipient device 350, and that the attachment file transferring means corresponds to the HTTP media delivery server 335. This assertion is not supportable.

Kirani does not disclose or suggest that the attachment-removed e-mail received by the recipient device 350 contains online location information of equipment pertaining to another transmission destination of the e-mail transmitted from the message originator 300. Accordingly, the recipient device 350 cannot correspond to the second e-mail receiving means of claim 2, because the recipient device 350 does not receive a second e-mail containing online location information of another transmission destination of the first e-mail and a transfer request for transferring the attachment to the other transmission destination. On the contrary, Kirani discloses that the recipient device 350 receives an attachment-removed e-mail that contains a URL allowing access to the attachment on the HTTP media server 350. However, the HTTP media server 350 is not another transmission destination of the first e-mail transmitted from the message originator 300, because the HTTP media server 350 receives only the attachment stored in the media storage repository 325, which receives only the attachment extracted from the first e-mail by the multimedia message extractor 320.

Furthermore, the HTTP media server 350 cannot correspond to the attachment file transferring means for two reasons. First, Kirani does not disclose or

suggest that the HTTP media server 350 transfers the attachment file to equipment pertaining to the another transmission destination of the original e-mail transmitted from the message originator 300. Second, the HTTP media server 350 does not transmit the attachment file in response to receiving the attachment-removed e-mail. In contrast to claim 2, Kirani does not disclose or suggest that the HTTP media server 350 receives any e-mail.

Therefore, Kirani does not disclose or suggest the second e-mail receiving means and attachment file transferring means of claim 2.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Kirani does not disclose or suggest the second e-mail receiving means and attachment file transferring means, as recited in claim 2. Applicant respectfully submits that claims 13, 20 and 27 are patentable for the same reasons.

(4) Independent Claims 7, 16, 23 and 32

Claim 7 recites an image processing device comprising a first e-mail receiving means for receiving a first e-mail having an attachment file, and an image forming means for forming images of the attachment file.

The image processing device of claim 7 also comprises a second e-mail receiving means for receiving a second e-mail containing a response request for responding with online location information, from another transmission destination of the first e-mail. In addition, the image processing device of claim 7 comprises an e-mail transmission means for transmitting a third e-mail containing the online location information to the another transmission destination in response to receiving of the second e-mail.

Furthermore, the image processing device of claim 7 comprises a transfer request receiving means for receiving a transfer request for transferring the attachment file transmitted in response to the third e-mail by equipment pertaining to the another transmission destination, and an attachment file transfer means for transmitting the attachment file to equipment pertaining to the another transmission destination in response to the transfer request.

In rejecting claim 7, the Office asserted that the HTTP delivery server 335 of Kirani corresponds to the second e-mail receiving means, the mail server 315

corresponds to the e-mail transmission means, and the HTTP delivery server 335 corresponds to the attachment file transfer means. This assertion is not supportable for the following reasons.

First, Kirani does not disclose or suggest that the HTTP delivery server 335 receives any e-mail, let alone a second e-mail containing a response request for responding with online information. The HTTP media server 350 is not a transmission destination of the first e-mail transmitted from the message originator 300 or the attachment-removed e-mail transmitted from the mail server 315, because the HTTP media server 350 receives only the attachment stored in the media storage repository 325, which receives only the attachment extracted from the first e-mail by the multimedia message extractor 320. In addition, Kirani does not disclose or suggest that the HTTP media server 350 receives an e-mail from another transmission destination of the first e-mail transmitted from the message originator 300.

Second, the mail server 315 of Kirani does not transmit the attachment-removed e-mail to another destination of the first e-mail transmitted from the message originator 300. Instead, Kirani discloses that the mail server 315 transmits the attachment-removed e-mail to the recipient device 350, which is the original transmission destination of the first e-mail transmitted from the message originator 300. Contrary to the Office's assertion, Kirani does not disclose or suggest that the mail server 315 transmits any e-mail to the HTTP delivery server 335.

Third, Kirani does not disclose or suggest that the HTTP delivery server 335 transmits the attachment file stored in the storage repository 325 to any device other than the recipient device 350 that was intended to receive the attachment. Kirani discloses that the HTTP delivery server 335 and recipient device 350 communicate via the HTTP protocol so that the recipient device 350 can obtain the attachment file stored in the storage repository 325. However, the recipient device 350, which is the original transmission destination of the first e-mail transmitted from the message originator 300, communicates with the HTTP media server 335 via the HTTP protocol once the recipient device 350 clicks on the URL included in the attachment-removed e-mail transmitted from the mail server 315. Therefore, Kirani does not disclose or suggest the HTTP media server 335 transmits the attachment file to

equipment pertaining to another transmission destination of the first e-mail transmitted from the message originator 300.

Accordingly, Kirani does not disclose or suggest that a device for forming images of an attachment file receives a second e-mail from another transmission destination of the first e-mail, and transfers the attachment file to the other transmission destination(s) in response to receiving the second e-mail, which contains a response request for responding with online location information of the image processing device to the other transmission destination(s) of the first e-mail.

Therefore, Applicant respectfully submits that Kirani does not disclose or suggest the second e-mail receiving means, e-mail transmission means and attachment file transfer means, as recited in claim 7. Consequently, Kirani does not disclose or suggest all the recited features of claim 7.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claim 7. Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claims 16, 23 and 32 for the same reasons.

(5) Independent Claims 3, 14, 21 and 28

Claim 3 recites an image processing device comprising e-mail transmitting means for transmitting a first e-mail having an attachment file. The image processing device of claim 3 comprises an e-mail receiving means for receiving a second e-mail from the transmission destination of the first e-mail. Claim 3 recites that the second e-mail contains online location information of equipment pertaining to the transmission destination of the first e-mail and a transfer request for transferring the attachment file to the transmission destination.

Accordingly, claim 3 recites that an image processing device, which sends a first e-mail having an attachment file, comprises functional elements for receiving a second e-mail from the transmission destination of the first e-mail, where the second e-mail contains online location information of equipment pertaining to the transmission destination of the first e-mail and a transfer request for transferring the attachment file to the transmission destination.

Contrary to the Office's assertion, Kirani does not disclose or suggest an

image processing device, which sends a first e-mail having an attachment file, receives a second e-mail from the transmission destination of the first e-mail, and transfers the attachment file to the equipment pertaining to the transmission destination of the first e-mail, as recited in claim 3.

In particular, Kirani does not disclose or suggest that the recipient device 350 receives a second e-mail from a transmission destination of the first e-mail, where the second e-mail contains online location information of equipment pertaining to the transmission destination of the first e-mail and a transfer request for transferring the attachment file to the transmission destination.

Accordingly, Applicant respectfully submits that Kirani does not disclose or suggest a device for transmitting a first e-mail, and receiving a second e-mail, which contains online location information of the transmission destination of the first e-mail, from the transmission destination of the first e-mail, as recited in claim 3.

Therefore, Applicant respectfully submits that Kirani does not disclose or suggest an image processing device that comprises all the recited elements of claim 3.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claim 3. Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claims 14, 21 and 28 for the same reasons.

(6) Independent Claims 8, 17, 24 and 33

Claim 8 recites an image processing device comprising a first e-mail transmitting means for transmitting a first e-mail having an attached file.

The image processing device of claim 8 also comprises an e-mail receiving means for receiving a second e-mail containing a response request for responding with online location information, from a transmission destination of the first e-mail.

In addition, the image processing device of claim 8 comprises a second e-mail transmission means for transmitting a third e-mail containing the online location information of the image processing device to the transmission destination in response to receiving of the second e-mail.



The Office addressed the features of claim 8 by asserting that it recites similar features to claims 1-7. Based on this reasoning, the Office rejected claim 8 for the same reasons presented in rejecting claims 1-7. As demonstrated above, the Office's interpretation and application of Kirani to claims 1-7 are not supportable. Nevertheless, in view of the Office's reliance on Kirani in rejecting claim 8, the rejection of claim 8 on the basis of Kirani is traversed for the following reasons.

As demonstrated above, the recipient device 350 does not receive a second e-mail from a transmission destination of the first e-mail, where the second e-mail contains a response request for responding with online location, from a transmission destination of the first e-mail transmitted from the message originator 300. Furthermore, Kirani does not disclose or suggest that the message originator 300 or mail server 315 receive a second e-mail from the recipient device 350, which is the transmission destination of the first e-mail transmitted from the message originator 300.

Accordingly, Applicant respectfully submits that Kirani does not disclose or suggest the first e-mail transmitting means and e-mail receiving means, as recited in claim 8.

Therefore, Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claim 8. Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of claims 17, 24 and 33 for the same reasons.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that Kirani does not disclose or suggest all the recited features of independent claims 1-3, 6-8, 12-17, 19-24, 26-28 and 31-33.

Therefore, Applicant respectfully submits that claims 1-3, 6-8, 12-17, 19-24, 26-28 and 31-33, as well as claims 4, 5, 9, 10, 29, 30, 34 and 35 which depend therefrom, are patentable over Kirani.

#### **VIII. Rejections Under 35 U.S.C. § 103(a)**

Dependent claims 5, 10, 30 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirani.

As demonstrated above, Kirani does not disclose or suggest all the recited features of 3, 8, 28 and 33, from which claims 5, 10, 30 and 35 respectively depend. Consequently, even assuming, *arguendo*, that the subject matter officially noticed by the Office is well-known in the art, the Official Notice does not cure the deficiencies of Kirani for failing to disclose or suggest all the recited features of claims 3, 8, 28 and 33, as well as claims 5, 10, 30 and 35 which depend therefrom.

Therefore, Applicant respectfully submits that claims 5, 10, 30 and 35 are also patentable over Kirani at least by virtue of their dependence from claims 3, 8, 28 and 33, respectively.

The foregoing explanation of the patentability of independent claims 1-3, 6-8, 12-17, 19-24, 26-28 and 31-33 is sufficiently clear such that it is believed to be unnecessary at this time to separately argue the patentability of the dependent claims or the subject matter recited in claims 5, 10, 30 and 35 that is alleged to be well-known. However, Applicant reserves the right to do so if it becomes appropriate.

## **IX. Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is clearly in condition for allowance. Accordingly, a favorable examination and consideration of the instant application are respectfully requested.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, the Examiner is respectfully requested to contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: March 27, 2008

By: /Jonathan R. Bowser/  
Jonathan R. Bowser  
Registration No. 54574

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620